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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,709	06/09/2005	Christian Wilms	10191/3925	9020
26646 7590 04/04/2008 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			EXAMINER JACKSON, MONIQUE R	
			ART UNIT 1794	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/517,709	Applicant(s) WILMS ET AL.	
	Examiner Monique R. Jackson	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The use of various trademarks has been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: 1) "coating contains at least 6% by weight of dry lubricant" (as in Claim 16, supported by original Claim 4); "plasma pretreating" (as in Claim 18, supported by original Claim 6).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 18-23 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of coating a wiper blade with a lubricating varnish comprising a polyurethane, a siloxane, and at least one of graphite, polytetrafluoroethylene, polypropylene or molybdenum disulfide, does not reasonably provide enablement for any lubricating varnish. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

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5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 12-17, 20, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Although alternative expressions are permissive in the claims, they should be drafted in proper alternative format, i.e. **“selected from A, B or C”**; **“at least one of A, B, or C”**; or in proper Markush claim format, i.e. **“selected from the group consisting of A, B and C”**. A claim that recites **“at least one of A, B and C”** is improper.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 12-14, 16-19, 21 and 23 are rejected under 35 U.S.C. 102(a) or (e) as being anticipated by Robertson (USPN 7,078,102, also printed as US 2002/0160203A1). Robertson teaches an aqueous, “one component” coating composition comprising a polyurethane, a wetting agent such as a polysiloxane, a slip aid such as waxes, silicone additives, fluorinated additives, and mixtures thereof, including polyethylene powders, polypropylene waxes, and

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polytetrafluoroethylene, in an amount of 0.1 to 15 wt % of the aqueous coating composition which has a 20-50wt% solids content (Abstract; Col. 2-Col. 4, lines 28.) Robertson teaches that the aqueous composition is particularly suited for coating elastomeric or rubber substrates in a single coat or multiple coats, with separate drying and crosslinking steps, or may be dried and crosslinked simultaneously, to produce a coated substrate suitable as a windshield wiper blade or vehicle weatherstrip (Col. 6; Claim 1.) Robertson further teach that the substrate, such as an EPDM substrate, may be pretreated with application of a primer coating, exposure to UV light, corona discharge or plasma, to increase the surface energy of the substrate prior to coating (Col. 6, lines 20-29.) In terms of Claim 19, the Examiner takes the position that the teachings of Robertson with respect to multiple coats of the aqueous coating composition comprising the slip aid powder reads upon the claimed invention.

9. Claims 12-14, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Chihara et al (USPN 5,115,007.) Chihara et al teaches a one-part, heat curable coating composition useful as a low friction coating for EPDM glass run channel or similar application such as a windshield wiper, wherein the coating composition comprises a polyurethane, a polysiloxane, and from 5 to about 60 parts per 100 parts by weight of a micropowders of polyethylene, nylon (polyamide), Teflon (polytetrafluoroethylene), or molybdenum disulfide; wherein the coating can be applied to EPDM or similar elastomeric substrate without a primer either before, concurrently with, or after vulcanization of the substrate (Abstract; Col. 1-Col. 2,, line 40; Col. 6, lines 57-67; Col. 7, lines 7-49; Examples.)

10. Claims 12-13, 16, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 08 048800 A (JP'800). JP'800 teaches a "one-component", low friction resin coating

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comprising a polyurethane, a polysiloxane, and a solid lubricant such as molybdenum disulfide, polytetrafluoroethylene, and graphite, in a loading amount of 50 to 300 weight parts per 100 weight parts resin, that may be applied to a vulcanized rubber substrate for use as weather strip or a wiper blade (0004-0010, 0020, Examples.) JP'800 teaches that the coating may be applied as a solution and heat cured.

11. Claims 19-21 are rejected under 35 U.S.C. 102(a) or (e) as being anticipated by Vogt et al (USPN 6,730,360, also printed as WO02/081582.) Vogt et al teach a one-component lubricant varnish and a method for coating elastomers such as windshield wiper blades utilizing the varnish comprising a polyurethane and a siloxane as well as polyamide powder or polyethylene powder in the varnish or applied subsequent to the varnish, wherein the method further comprises temperature treating the varnish before or after applying the powder as claimed (Abstract; Col. 2, lines 56-65; Col. 4-Col. 6, line 31; Claims 10-19.)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 15, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson. The teachings of Robertson are discussed above. Robertson does not teach that the slip aid waxes or powders have a particle size less than 30 microns, however, one having ordinary skill in the art at the time of the invention would have been motivated to determine the optimum particle size wherein the claimed range would have been obvious based on Robertson's teaching of a wet coating thickness of from 5 microns to 150 microns, and the use of particle sizes within the claimed range in the art. With regards to Claim 20, though Robertson teaches multiple coating steps and that the coating can be first dried and then crosslinked, Robertson does not specifically teach a separate drying step between coatings. However, a coating process utilizing intermediate drying steps or multiple drying steps is conventional in the art and would have been obvious to one having ordinary skill in the art at the time of the invention. Lastly, though Robertson teaches that the coating can be applied to a rubber substrate such as EPDM for use as a wiper blade, Robertson does not specifically teach extruding the blade, which is commonly the method employed to produce wiper blade as is well established in the art, and then vulcanizing the blade after coating. However, similar to the above, one skilled in the art at the time of the invention would have been motivated to simultaneously cure and vulcanize the coating and substrate to reduce the number of curing steps as is conventional in the art.

14. Claims 15 and 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chihara et al. The teachings of Chihara et al are discussed above. Chihara et do not specifically teach that the micropowders have a particle size less than 30 microns, however, one having ordinary skill in the art at the time of the invention would have been motivated to determine the

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optimum particle size wherein the claimed range would have been obvious based on Chihara's examples which utilize similar micropowders with particle sizes within the claimed range, and have coating thickness values less than 30 microns. Further, it is noted that solid lubricants with particle sizes within the claimed range are typically utilized in the art. With regards to process claims, though Chihara et al teach that the coatings can be applied to a substrate without a primer pretreatment and either before, concurrently with, or after vulcanization of the substrate, the fact that Chihara et al recites "can" provides a suggestion to one skilled in the art that a pretreatment step is optional and can be included, wherein plasma pretreatment is an obvious pretreatment method to improve coating adhesion to a rubber substrate. Further, one skilled in the art at the time of the invention would have been motivated to determine the optimum number of coating and drying steps to provide the desired thickness for a particular end use. Lastly, though Chihara et al do not specifically teach that the substrate such as the wiper blade is formed by extrusion, it is well established in the art that wiper blades are conventionally formed by extrusion and hence an extruding step would have been obvious.

Double Patenting

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

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ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 18-23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,730,360. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art at the time of the invention to combine claim limitations and to include a plasma pretreatment step to improve adhesion of the coating to the elastomer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 10:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Monique R Jackson/
Primary Examiner, Art Unit 1794
March 28, 2008